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ORACLE AMERICA, INC.

22 ORACLE AMERICA, INC.

23 Plaintiff,

24 v.

25 GOOGLE, INC.

26 Defendant.

Case No. 3:10-cv-03561-WHA

Honorable Judge William H. Alsup

**ORACLE AMERICA, INC.’S REPLY
TO DEFENDANT GOOGLE INC.’S
ANSWER TO COMPLAINT FOR
PATENT AND COPYRIGHT
INFRINGEMENT AND
COUNTERCLAIMS**

JURY TRIAL DEMANDED

1 **ORACLE AMERICA, INC.'S REPLY TO DEFENDANT GOOGLE INC.'S**
 2 **COUNTERCLAIMS**

3 Plaintiff Oracle America, Inc. responds to each of the numbered paragraphs of the
 4 counterclaims of Defendant Google, Inc., as set forth in its Answer to Plaintiff's Complaint for
 5 Patent and Copyright Infringement and Counterclaims, as follows:

6 **GENERAL ALLEGATIONS**

7 1. Answering Paragraph 1, Oracle America admits, on information and belief, that Google
 8 is a corporation organized and existing under the laws of the State of Delaware, with its principal
 9 place of business at 1600 Amphitheatre Parkway, Mountain View, California 94043.

10 2. Answering Paragraph 2, Oracle America admits that Oracle America, Inc. is a
 11 corporation organized and existing under the laws of the State of Delaware, with its principal place
 12 of business at 500 Oracle Parkway, Redwood City, California 94065. Oracle America admits that
 13 Oracle Corporation is a corporation organized and existing under the laws of the State of Delaware,
 14 with its principal place of business at 500 Oracle Parkway, Redwood City, California 94065.
 15 Oracle America is a subsidiary of Oracle Systems Corporation, not of Oracle Corp.

16 **JURISDICTION AND VENUE**

- 17 3. Paragraph 3 contains conclusions of law to which no response is required.
 18 4. Paragraph 4 contains conclusions of law to which no response is required.

19 **FACTUAL BACKGROUND ALLEGATIONS**

20 5. Answering Paragraph 1, Oracle America admits that the Java platform includes the
 21 Java programming language and a runtime environment. Oracle America admits that Sun
 22 Microsystems, Inc. ("Sun") developed the Java platform in the 1990s. Oracle America denies any
 23 remaining allegations of Paragraph 1.

24 6. Answering Paragraph 2, Oracle America admits that the Java programming language
 25 has syntax similar to C++, an existing object-oriented language. Oracle America admits that the
 26 Java platform implemented a technique wherein programs written in the Java programming
 27 language can be compiled into intermediate instructions called "bytecode" to be executed on a
 28 computer that implements a Java "virtual machine." Oracle America admits that the virtual

1 machine, typically a program, receives and executes the bytecode upon which the virtual machine is
2 running. Oracle America admits that so long as there is a Java virtual machine available for a given
3 computer system, any program compiled from the Java programming language into Java bytecode
4 could theoretically run on the Java virtual machine for that computer. Oracle America admits that
5 Sun's Java bytecode instructions are stack-oriented, which is supported by Sun's Java virtual
6 machines, where data and parameters can be loaded onto data structures in the computer's memory
7 called "stacks" and instructions can then be executed using the data and parameters from the stack.
8 Oracle America denies any remaining allegations of Paragraph 2.

9 7. Answering Paragraph 3, Oracle America admits that the Java platform includes many
10 different components, including utilities to assist with the development of source code written in the
11 Java programming language, a Java compiler that compiles Java programming language source
12 code to Java bytecode, a Java runtime environment including Java virtual machines written to
13 operate on a number of different computer platforms, and a set of extensive class libraries that can
14 be accessed and reused by Java platform applications and can be used to perform software
15 functions, such as writing to files or sorting data. Oracle America denies any remaining allegations
16 of Paragraph 3.

17 8. Answering Paragraph 4, Oracle America admits that Sun developed and distributed the
18 Java Standard Edition ("Java SE") and other editions of the Java platform. Oracle America admits
19 that Java platform editions may typically include a development environment, a Java compiler, Java
20 virtual machine, a set of class libraries, and documentation. Oracle America admits that Java
21 platform editions may provide a different set of class libraries based on the types of applications
22 and environment at which an edition is targeted. Oracle America denies any remaining allegations
23 of Paragraph 4.

24 9. Answering Paragraph 5, Oracle America admits that Sun released some source code for
25 Java SE and other editions in 2006 and 2007 subject to the terms of the GNU Public License,
26 version 2 ("GPLv2"). Oracle America denies any remaining allegations of Paragraph 5.

27 10. Answering Paragraph 6, Oracle America admits that Sun published its copyrighted
28 Java specifications and offered licenses to them under certain conditions. For example, in the case

1 of the Java 2 Platform, Standard Edition, Sun permitted developers to create “clean room”
2 implementations of Sun’s Java specifications provided that they comply with all applicable license
3 requirements, including requirements that they (i) include a complete implementation of the current
4 version of the specification without subsetting or supersetting; (ii) implement all the interfaces and
5 functionality of the required packages of the Java 2 Platform, Standard Edition, as defined by Sun,
6 without subsetting or supersetting; (iii) do not add any additional packages, classes, or interfaces to
7 the java.* or javax.* packages or their subpackages; (iv) pass all test suites relating to the most
8 recent published version of the specification of the Java 2 Platform, Standard Edition, that are
9 available from Sun (the Technology Compatibility Kits) six (6) months prior to any beta release of
10 the clean room implementation or upgrade thereto; (v) do not derive from Sun source code or
11 binary materials; and (vi) do not include any Sun source code or binary materials without an
12 appropriate and separate license from Sun. Google is not in compliance with these license
13 conditions. Developers were well aware that Sun’s specification license requires compatibility
14 testing using Sun’s TCKs, which were and are available free of charge to qualifying universities,
15 colleges, not-for-profit organizations, and individuals (*see* <http://java.sun.com/scholarship/>). Oracle
16 America lacks sufficient knowledge or information to admit or deny the remainder of the
17 allegations of Paragraph 6, and, on that basis, denies them.

18 11. Oracle America has filed a motion under Rule 12(f) to strike Google’s allegations in
19 Paragraphs 7-22. In accordance with Rule 12(a)(4), Oracle America is not required to respond to
20 these allegations until after disposition of its motion.

21 12. Answering Paragraph 23, Oracle America admits that Oracle America asserts that
22 Google infringes U.S. Reissue Patent No. RE38,104 (“the ’104 reissue patent”), and U.S. Patent
23 Nos. 5,966,702 (“the ’702 patent”), 6,061,520 (“the ’520 patent”), 6,125,447 (“the ’447 patent”),
24 6,192,476 (“the ’476 patent”), 6,910,205 (“the ’205 patent”), and 7,426,720 (“the ’720 patent”)
25 (collectively “the Patents-in-Suit”). Oracle America admits that Oracle America asserts that Google
26 infringes and induces Android users and developers to infringe certain copyrights attached to
27 Oracle America’s Complaint as Exhibit H (“the Asserted Copyrights”). Oracle America denies any
28 remaining allegations of Paragraph 23.

13. Answering Paragraph 24, Oracle America denies the allegations of Paragraph 24.

14. Answering Paragraph 25, Oracle America admits that an actual case or controversy exists between Google and Oracle America over the Patents-in-Suit. Oracle America denies any remaining allegations of Paragraph 25.

COUNT ONE

Declaratory Judgment of Non-Infringement of U.S. Reissue Patent No. RE 38,104

15. Answering Paragraph 26, Oracle America incorporates by reference its responses to the allegations of Paragraphs 1 through 25 of the Counterclaims.

16. Answering Paragraph 27, Oracle America admits that an actual case or controversy exists between Google and Oracle America as to whether the '104 reissue patent is infringed by Google.

17. Answering Paragraph 28, Oracle America denies the allegations of Paragraph 28.

18. Answering Paragraph 29, Oracle America denies the allegations of Paragraph 29.

19. Answering Paragraph 30, Oracle America admits that this case is exceptional and alleges that Oracle America is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle America denies any remaining allegations of Paragraph 30.

COUNT TWO

Declaratory Judgment of Invalidity of U.S. Reissue Patent No. RE 38,104

20. Oracle America has filed a motion under Rule 12(b)(6) to dismiss Google's Counterclaims Counts Two, Four, Six, Eight, Ten, Twelve, and Fourteen. In accordance with Rule 12(a)(4), Oracle America is not required to respond to the allegations of Paragraphs 31-35 until after disposition of its motion.

COUNT THREE

Declaratory Judgment of Non-Infringement of U.S. Patent No. 5,966,702

21. Answering Paragraph 36, Oracle America incorporates by reference its responses to the allegations of Paragraphs 1 through 35 of the Counterclaims.

22. Answering Paragraph 37, Oracle America admits that an actual case or controversy exists between Google and Oracle America as to whether the '702 patent is infringed by Google.

23. Answering Paragraph 38, Oracle America denies the allegations of Paragraph 38.
24. Answering Paragraph 39, Oracle America denies the allegations of Paragraph 39.
25. Answering Paragraph 40, Oracle America admits that this case is exceptional and alleges that Oracle America is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle America denies any remaining allegations of Paragraph 40.

COUNT FOUR

Declaratory Judgment of Invalidity of U.S. Patent No. 5,966,702

8 26. Oracle America has filed a motion under Rule 12(b)(6) to dismiss Google's
9 Counterclaims Counts Two, Four, Six, Eight, Ten, Twelve, and Fourteen. In accordance with Rule
10 12(a)(4), Oracle America is not required to respond to the allegations of Paragraphs 41-45 until
11 after disposition of its motion.

COUNT FIVE

Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,061,520

14 27. Answering Paragraph 46, Oracle America incorporates by reference its responses to
15 the allegations of Paragraphs 1 through 45 of the Counterclaims.

16 28. Answering Paragraph 47, Oracle America admits that an actual case or controversy
17 exists between Google and Oracle America as to whether the '520 patent is infringed by Google.

18 29. Answering Paragraph 48, Oracle America denies the allegations of Paragraph 48.

19 30. Answering Paragraph 49, Oracle America denies the allegations of Paragraph 49.

20 31. Answering Paragraph 50, Oracle America admits that this case is exceptional and
21 alleges that Oracle America is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle
22 America denies any remaining allegations of Paragraph 50.

COUNT SIX

Declaratory Judgment of Invalidity of U.S. Patent No. 6,061,520

25 32. Oracle America has filed a motion under Rule 12(b)(6) to dismiss Google's
26 Counterclaims Counts Two, Four, Six, Eight, Ten, Twelve, and Fourteen. In accordance with Rule
27 12(a)(4), Oracle America is not required to respond to the allegations of Paragraphs 51-55 until
28 after disposition of its motion.

COUNT SEVEN**Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,125,447**

33. Answering Paragraph 56, Oracle America incorporates by reference its responses to
4 the allegations of Paragraphs 1 through 55 of the Counterclaims.

5 34. Answering Paragraph 57, Oracle America admits that an actual case or controversy
6 exists between Google and Oracle America as to whether the '447 patent is infringed by Google.

7 35. Answering Paragraph 58, Oracle America denies the allegations of Paragraph 58.

8 36. Answering Paragraph 59, Oracle America denies the allegations of Paragraph 59.

9 37. Answering Paragraph 60, Oracle America admits that this case is exceptional and
10 alleges that Oracle America is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle
11 America denies any remaining allegations of Paragraph 60.

COUNT EIGHT**Declaratory Judgment of Invalidity of U.S. Patent No. 6,125,447**

14 38. Oracle America has filed a motion under Rule 12(b)(6) to dismiss Google's
15 Counterclaims Counts Two, Four, Six, Eight, Ten, Twelve, and Fourteen. In accordance with Rule
16 12(a)(4), Oracle America is not required to respond to the allegations of Paragraphs 61-65 until
17 after disposition of its motion.

COUNT NINE**Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,192,476**

20 39. Answering Paragraph 66, Oracle America incorporates by reference its responses to
21 the allegations of Paragraphs 1 through 65 of the Counterclaims.

22 40. Answering Paragraph 67, Oracle America admits that an actual case or controversy
23 exists between Google and Oracle America as to whether the '476 patent is infringed by Google.

24 41. Answering Paragraph 68, Oracle America denies the allegations of Paragraph 68.

25 42. Answering Paragraph 69, Oracle America denies the allegations of Paragraph 69.

26 43. Answering Paragraph 70, Oracle America admits that this case is exceptional and
27 alleges that Oracle America is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle
28 America denies any remaining allegations of Paragraph 70.

COUNT TEN

Declaratory Judgment of Invalidity of U.S. Patent No. 6,192,476

44. Oracle America has filed a motion under Rule 12(b)(6) to dismiss Google's Counterclaims Counts Two, Four, Six, Eight, Ten, Twelve, and Fourteen. In accordance with Rule 12(a)(4), Oracle America is not required to respond to the allegations of Paragraphs 71-75 until after disposition of its motion.

COUNT ELEVEN

Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,910,205

45. Answering Paragraph 76, Oracle America incorporates by reference its responses to the allegations of Paragraphs 1 through 75 of the Counterclaims.

46. Answering Paragraph 77, Oracle America admits that an actual case or controversy exists between Google and Oracle America as to whether the '205 patent is infringed by Google.

47. Answering Paragraph 78, Oracle America denies the allegations of Paragraph 78.

48. Answering Paragraph 79, Oracle America denies the allegations of Paragraph 79.

49. Answering Paragraph 80, Oracle America admits that this case is exceptional and alleges that Oracle America is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle America denies any remaining allegations of Paragraph 80.

COUNT TWELVE

Declaratory Judgment of Invalidity of U.S. Patent No. 6,910,205

50. Oracle America has filed a motion under Rule 12(b)(6) to dismiss Google's Counterclaims Counts Two, Four, Six, Eight, Ten, Twelve, and Fourteen. In accordance with Rule 12(a)(4), Oracle America is not required to respond to the allegations of Paragraphs 81-85 until after disposition of its motion.

COUNT THIRTEEN

Declaratory Judgment of Non-Infringement of U.S. Patent No. 7,426,720

51. Answering Paragraph 86, Oracle America incorporates by reference its responses to the allegations of Paragraphs 1 through 85 of the Counterclaims.

52. Answering Paragraph 87, Oracle America admits that an actual case or controversy exists between Google and Oracle America as to whether the '720 patent is infringed by Google.

53. Answering Paragraph 88, Oracle America denies the allegations of Paragraph 88.

54. Answering Paragraph 89, Oracle America denies the allegations of Paragraph 89.

55. Answering Paragraph 90, Oracle America admits that this case is exceptional and alleges that Oracle America is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle America denies any remaining allegations of Paragraph 90.

COUNT FOURTEEN

Declaratory Judgment of Invalidity of U.S. Patent No. 7,426,720

56. Oracle America has filed a motion under Rule 12(b)(6) to dismiss Google's Counterclaims Counts Two, Four, Six, Eight, Ten, Twelve, and Fourteen. In accordance with Rule 12(a)(4), Oracle America is not required to respond to the allegations of Paragraphs 91-95 until after disposition of its motion.

PRAAYER FOR RELIEF

Oracle America denies that Google is entitled to any of the relief for which it prays as to any cause of action, and specifically denies all allegations and prayers for relief contained in subparagraphs a-h of Google's Answer and Counterclaims.

Dated: October 28, 2010

MICHAEL A. JACOBS
MARC DAVID PETERS
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By: /s/ Marc David Peters

Attorneys for Plaintiff
ORACLE AMERICA, INC.

Attestation of Concurrence

I, Richard S. Ballinger, as the ECF user and filer of this document, attest that concurrence in the filing of this document has been obtained from each of the above signatories.

Dated: October 28, 2010

By: /s/ Richard S. Ballinger
Richard S. Ballinger

Counsel to Plaintiff
ORACLE AMERICA, INC.